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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/555,105

12/12/2006

Wolfram Andersch

ANDERSCH=1

2886

1444 7590 02/28/2011

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EXAMINER

PACKARD, BENJAMIN J

ART UNIT

PAPER NUMBER

1612

MAIL DATE

DELIVERY MODE

02/28/2011

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Advisory Action  
Before the Filing of an Appeal Brief**

**Application No.**

10/555,105

**Applicant(s)**

ANDERSCH ET AL.

**Examiner**

BENJAMIN PACKARD

**Art Unit**

1612

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 09 February 2011 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 5 months from the mailing date of the final rejection.  
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**NOTICE OF APPEAL**

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

**AMENDMENTS**

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☐ They raise the issue of new matter (see NOTE below);  
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.  
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
The status of the claim(s) is (or will be) as follows:  
Claim(s) allowed: \_\_\_\_\_.  
Claim(s) objected to: \_\_\_\_\_.  
Claim(s) rejected: 2-5 and 8-14.  
Claim(s) withdrawn from consideration: \_\_\_\_\_.

**AFFIDAVIT OR OTHER EVIDENCE**

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

**REQUEST FOR RECONSIDERATION/OTHER**

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
See Continuation Sheet.  
12. ☒ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). 2pgs(10/08/10)  
13. ☒ Other: See Continuation Sheet.

/Frederick Krass/  
Supervisory Patent Examiner, Art Unit 1612

/Benjamin Packard/  
Examiner, Art Unit 1612

Continuation of 11. does NOT place the application in condition for allowance because:

Claims 2-5 and 8-14 stand rejected under 35 U.S.C. 103(a) as being unpatentable over teachings of Watanabe et al (WO 01/02378, see IDS dated 03/09/07) in view of Cullen et al (US 4,748,186, see 892 dated 6/16/08), and Assmann et al (US 6,277,791, see 892 dated 6/16/08).

Applicants assert the skilled artisan would not have a reasonable expectation of whether the combinations instantly claims would have additive, synergistic, or antagonistic effects. Applicants specifically cite the instant specification for the generic teaching of Watanabe reference and not the absence of any experimental data showing a synergistic effect against insects or fungi. To the contrary, Applicants assert Watanabe teaches that "in many cases" the results are synergistic and obviousness cannot be predicted on what is unknown. Applicants then assert that undue experimentation would be required to determine which, if any, combinations result in synergistic effects.

Examiner disagrees. First, with regards to the obviousness rejection, Examiner notes that the determination of obviousness is based on the factual inquiry set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966). As discussed in previous Office Actions, the scope and content of the prior art is directed to combinations of known agrochemical agents. The difference between the prior art and the claims at issue is simply the instant claims are directed to combinations of the disclosed components in the prior art. Then looking to the evidence of the present application indicating nonobviousness, the only indicators appear to be Applicants assertion that combinations will not have a synergistic effect. Even the prior art recognizes not all combinations will have synergistic effect, but does suggest that some will. Routine testing may be permitted to determine which combinations provide the desired effect. see *In re Kollman*, 201 USPQ 193 (CCPA 1979). Thus, the skilled artisan, would find it obvious to follow the guidance provided by the prior art for determining which combinations would provide synergistic effects.

Further, the prior art teaches the addition of extenders and/or surface active agents which would also increase the activity of the active agents, given the exposure of the active would increase. As such, there is a much higher expectation of increased activity where such compounds are specifically taught to be "synergistic" agents.

Second, with regards to the unexpected results, Examiner notes that all of the instant claims except claim 8 are directed to compositions. Therefore, the motivation to combine the components is directly supported by Watanabe for reasons of record. As such, the analysis then turns to whether unexpected results are present. Looking to the instant specification, there are a limited number of embodiments which are disclosed by Applicants which are asserted to have super-additive results (see instant spec at pgs 33-41). The analysis then turns to the instant claims to see if the results are commensurate in scope of the claims. Here, while the claims appear to be limited to the drugs actually tested, the claims are not limited to the breadth of the concentration ranges which show the unexpected results. As such, it is unclear if the asserted results would be the same should the concentrations of the two agents be varied to minimal amounts.

Further, it is unclear if a surface extender or other synergistic additive would likewise produce the same effect. As the claims are not limited to the recited components, synergistic effects would not be unexpected when the additional synergistic additives were added.

Continuation of 13. Other: Additional IDS: 1pg(02/09/11).